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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,184	07/30/2003	Naina Sachdev	Sa-1	9221

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EXAMINER	
CHOI, FRANK I	

ART UNIT	PAPER NUMBER
1616	

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/630,184	SACHDEV, NAINA	
	Examiner	Art Unit	
	Frank I Choi	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *20040726,20040121*20031229
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1,2,5,7,8 are rejected under 35 U.S.C. 102(a or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Boussouira et al. (US Pat. 6,358,514).

Boussouira et al. expressly discloses a composition containing 0.1% carnosine or carnosine derivative, all-trans retinol, ethanol and water at a pH of 8.2 falling within the scope of applicant's claims (column 10, lines 30-53).

Alternatively, at the very least the claimed invention is rendered obvious within the meaning of 35 USC 103, because the prior art discloses products that contain the same exact ingredients/components as that of the claimed invention. See In re Fitzgerald, 205 USPQ 594 (CCPA 1980). See also In re May, 197 USPQ 601, 607 (CCPA 1978).

Claims 1-3, 5,7,8 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bagrov et al. (US Pat. 6,629,970).

Bagrov et al. expressly discloses a composition containing 0.1-20 mg/ml carnosine, complex of glycosaminoglycans with at least one metal of calcium, magnesium, zinc, aluminum, copper, iron or manganese with a pH of 7.2-7.6 (Column 1, lines 53-68, Column 2, lines 1-12, Claim 1, Claim 3) falling within the scope of applicant's claims (column 10, lines 30-53).

Alternatively, at the very least the claimed invention is rendered obvious within the meaning of 35 USC 103, because the prior art discloses products that contain the same exact ingredients/components as that of the claimed invention. See In re Fitzgerald, 205 USPQ 594 (CCPA 1980). See also In re May, 197 USPQ 601, 607 (CCPA 1978).

Claims 1-5, 7,8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boussouira et al. (US Pat. 6,358,514).

Boussouria et al. disclose a composition having a pH of preferably greater than equal to 7 and less than or equal to 10, for example 7.5, 8.0, 8.5, 9.0, 9.5, a carnosine derivative (0.001 to 20% by weight, advantageously from 0.05 to 10%, including 0.5, 1,2,5,15, and 18% by weight) and retinoid which is applied to the skin or face and can be in the form of a lotion, gel, w/o or o/w emulsion, care cream, milk, tonic, cleansing and/or make-up-removing product, erasing product, exfoliant, sunscreen or foundation (Column 4, lines 33-68, Columns 4-9, Column10, lines 1-7) A example is disclosed containing carnosine or carnosine derivative, all-trans retinol, ethanol and water at a pH of 8.2 (column 10, lines 15-63). It is disclosed that addition of carnosine derivative to the retinoid increase the stability of the retinoid (Column 11, lines 1-20).

The difference between the prior art and the claimed invention is that the prior art does not expressly disclose the use of a carnosine derivative in an amount of about 1.5% to about 30%, or 10% to 20% by weight. However, the prior art amply suggests the same as the prior art disclose the use of 0.001 to 20% by weight, advantageously from 0.05 to 10%, including 0.5, 1,2,5,15, and 18% by weight of the carnosine derivative. As such, it would have been well within the of and one of ordinary skill in the art would have expected that the use of varying amounts of carnosine derivative, including amounts falling within the claimed ranges, would be effective in stabilizing the retinoid contained in the prior art composition.

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been taught by the teachings of the cited reference.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grigg (US 2003/0118525) in view of Boussouira et al. (US Pat. 6,358,514).

Grigg discloses a composition containing carnosine, compounds related to carnosine, acylcarnosines, such as N-acetyl carnosine, and esters of acylcarnosines, preferable in combination with other antioxidants such as vitamin E, lipoic acid, cysteine, cysteine derivatives, folic acid, phytic acid, citric acid, lactic acid, zinc oxide, ubiquinone, in the form of a gel, cream or other cosmetic formulations (paragraphs 0025-0031, 0036-0046) A cosmetic cream is disclosed containing 0.1% or 1.00 % carnosine or 0.1% acetylcarnosine (Paragraphs 0056-0057). It is disclosed that carnosine and N-acetyl carnosine are effective in blocking erythema and oedema induced by exposure of the skin to solar radiation (Paragraphs 0013-0024)

Boussouira et al. (US Pat. 6,358,514) is cited for the same reasons as above and are is incorporated herein to avoid repetition.

The difference between the prior art and the claimed invention is that the prior art does not expressly disclose the use of a carnosine derivative in an amount of about 1.5% to about 30%, or 10% to 20% by weight or the use of N-acetyl carnosine. However, the prior art amply suggests the same as the prior art disclose the use of 0.001 to 20% by weight, advantageously from 0.05 to 10%, including 0.5, 1,2,5,15, and 18% by weight of the carnosine derivative. As such, it would have been well within the of and one of ordinary skill in the art would have expected that the use of varying amounts of carnosine derivative, including amounts falling within the claimed ranges, or the use of N-acetyl carnosine would be effective in stabilizing the retinoid contained in the prior art composition.

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been taught by the teachings of the cited reference.

Conclusion

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is 571-273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (571)272-0610. Examiner maintains a flexible schedule. However, Examiner may generally be reached Monday-Friday, 8:00 am – 5:30 pm (EST), except the first Friday of the each biweek which is Examiner's normally scheduled day off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Gary Kunz, can be reached at 571-272-0887. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (571) 272-1600.

FIC
December 19, 2004

JOHN PAK
PRIMARY EXAMINER
GROUP 1600